

**REMARKS**

In the Office Action dated April 20, 2004, claims 1-18 were presented for examination. Claims 1-10 and 15-18 were rejected under 35 U.S.C. §102(e). Claims 11-14 were rejected under 35 U.S.C. §101. Claims 8-10 were rejected under 35 U.S.C. §112, second paragraph.

Applicant wishes to thank the Examiner for the careful and thorough review and action on the merits in this application. The following remarks are provided in support of the pending claims and responsive to the Office Action of April 20, 2004 for the pending application.

**I. Rejection of claims 8-10 under 35 U.S.C. §112, second paragraph**

In the Office Action of April 20, 2004, the Examiner assigned to the application rejected claims 8-10 under 35 U.S.C. §102(b) as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. More specifically, claims 8-10 were originally shown to depend from claim 6. Applicant has amended claims 8-10 to correct the dependency to claim 7. Accordingly, claims 8-10 which are system claims have been amended to depend from claim 7, a system claim.

**II. Rejection of claims 11-14 under 35 U.S.C. §101**

In the Office Action of April 20, 2004, the Examiner assigned to the application rejected claims 11-14 under 35 U.S.C. §101 as being drawn to non-statutory subject matter. Claim 11 has been amended to claim the subject matter as being embodied in a computer readable media. This claim structure defines the structural and functional interrelationships between the kernel module and the medium and the diagnostic program and the medium which permits the cache hardware diagnostics functionality to be realized. Accordingly, removal of the rejection under 35 U.S.C. §101 is respectfully requested.

**III. Rejection of claims 1-10 and 15-18 under 35 U.S.C. §102(e)**

Claims 1-10 and 15-18 were rejected under 35 U.S.C. §102(e) as being anticipated by *Frey*. The *Frey* article relates to memory mapping between physical and virtual addresses. More specifically, *Frey* discloses allocating contiguous physical memory, and a method for checking for correctness of the mapping between the physical and virtual addresses. However, *Frey* does not show a diagnostic or method of conducting a diagnostic for cache hardware in the contiguous physical memory. Rather, *Frey* shows a method for conducting a test on the memory mapping, which is not a diagnostic test on the cache hardware. Accordingly, the testing of the memory mapping between the physical and virtual addresses of *Frey* operate under different parameters and a different environment than that claimed by Applicant.

Applicant's invention applies to cache hardware and conducting diagnostics on the cache hardware in the contiguous physical memory enabled by the dynamically loadable module. The diagnostic is supported by loading of the module and allocation of contiguous physical memory by the kernel. There is no teaching in *Frey* for performing cache hardware diagnostics in the contiguous physical memory. In order for the claimed invention to be anticipated under 35 U.S.C. §102(e), the prior art must teach all claimed limitations presented by the claimed invention. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131 (citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F. 2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987)). As mentioned above, *Frey* does not show all of the elements as claimed by Applicant in pending claims 1-10 and 15-18. Specifically, *Frey* does not support the use of performing a diagnostic on cache lines (hardware), as shown in Applicant's amended claims, rather *Frey* merely shows support for testing correctness on memory mapping (software). Accordingly, *Frey* clearly fails to teach the limitations pertaining to the cache line diagnostic as presented in Applicant's pending claims 1-10 and 15-18.

Finally, "[a] previous patent anticipates a purported invention only where, except for insubstantial differences, it contains all of the same elements operating in the same fashion to perform an identical function." *Saunders v. Air-Flo Co.*, 646 F.2d 1201, 1203 (7<sup>th</sup> Cir. 1981) citing *Popeil Brothers, Inc. v. Schick Electric, Inc.*, 494 F. 2d 162, 164 (7<sup>th</sup> Cir. 1974) (holding

patents were not invalid as being anticipated by or obvious in light of prior art). *Frey* does not anticipate the invention of Applicant based upon the legal definition of anticipation. Although the prior art cited by the Examiner relates to memory mapping and testing associated therewith, *Frey* fails to show each and every element as presented in Applicant's claimed invention. In fact, *Frey* does not show testing or diagnostics associated with cache lines. Accordingly, Applicant respectfully requests the Examiner remove the rejection of claims 1-10 and 15-18 and provide allowance of this application.

For the reasons outlined above, withdrawal of the rejection of record and an allowance of this application are respectfully requested.

Respectfully submitted,

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